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Paper Number

In re application of

Anita Marten

Serial No. 09/991,022

Filed: November 21, 2001

For: INITIAL SOLIDS MIXTURE FOR
A LATER ORGANIC COATING APPLICATION

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: DECISION ON
: PETITION
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This is a response to the PETITION FOR WITHDRAWAL OF ERRONEOUS ABANDONMENT HOLDING, filed August 12, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of July 01, 2004 for failure to file a proper Request for Continued Examination ("RCE") be withdrawn since the applicants did timely file a REQUEST FOR CONTINUED EXAMINATION (RCE) and an AMENDMENT on April 12, 2004 along with the required fee.

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the evidence presented reveals that the REQUEST FOR CONTINUED EXAMINATION (RCE) and the AMENDMENT were properly filed on April 12, 2004 as evidenced by the properly completed Request for Continued Examination filed April 12, 2004 in that 1) prosecution on the merits is closed as evidenced by the FINAL action mailed October 10, 2003, 2) applicants filed a submission under 37 C.F.R. 1.114 with the Request for Continued Examination as evidenced by the accompanying amendment filed April 12, 2004 and 3) that applicants had paid the fee set forth under 37 C.F.R. 1.17(e). To properly meet the requirements of 37 C.F.R. 1.114., the submission must satisfy the requirements of 37 C.F.R. 1.111 when the submission is a reply to an Office action under 35 U.S.C. 132 (see 37 C.F.R. 1.114(b)). Consistent with the requirements of 37 C.F.R. 1.111, the amendment filed April 04, 2004 appears to be a *bona fide* attempt by applicant to advance prosecution in that the amendment was in writing and specifically and distinctly pointed out the errors in the examiner's action and replied to every ground of objection and rejection in the FINAL office action mailed October 10, 2003 as evidenced in the amendment at pages 4-6 wherein applicant addressed the 35 USC 112 first and second paragraph rejections, restriction requirement by original presentation. Thus applicant has fulfilled the requirements of 37 C.F. R. 1.111 and met the submission requirement of 37 C.F.R. 1.114.

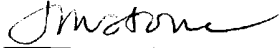
Furthermore, Section 706.07(h)(VI) further states that one situation where a submission is not a fully responsive submission, but is a *bona fide* attempt to provide a complete reply" is presentation of claims for (a) different invention." In this regard, M.P.E.P. j 706.07(h)(VI) states that if an RCE is filed with an amendment canceling all claims drawn to the elected invention and presenting only claims drawn to a nonelected invention, the RCE should be treated as proper but the amendment should not be entered and that the amendment is not fully responsive and applicant should be given a time period of one month or thirty days (whichever is longer) to submit a complete reply. This practice is consistent with 37 C.F.R. 1.135(c) and 1.145 and with the procedure outlined in M.P.E.P. 821.03, which section is referred to by M.P.E.P. 706.07(h)(VI). Accordingly, even if the Amendment submitted with the RCE is considered to present claims that are independent and distinct from the claims previously claimed, it would have been proper for the Office to provide Applicant with an opportunity to submit a complete reply, to seek reconsideration under 37 C.F.R. 1.143 and/or to petition to the Director under 37 C.F.R. 1.144 rather than to hold the present application abandoned. Accordingly, the holding of the present application

abandoned was improper and in direct contravention to the procedures specifically outlined in M.P.E.P. 706.07(h)(VI) and 821.03.

Accordingly, any holding of abandonment for failure to file a proper REQUEST FOR CONTINUED EXAMINATION is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the REQUEST FOR CONTINUED EXAMINATION (RCE) and the AMENDMENT originally filed April 12, 2004.

The Petition is **GRANTED**.



Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Richard L. Mayer
Kenyon & Kenyon
One Broadway
New York, New York 10004